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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/834,778      | 04/12/2001  | Daniel P. Silver     | 20363-011           | 3764             |

7590 07/09/2004  
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GLOVSKY and POPEO, P.C.  
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Boston, MA 02111

EXAMINER

SULLIVAN, DANIEL M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1636

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26

Please find below and/or attached an Office communication concerning this application or proceeding.

|   |                        |                     |  |
|---|------------------------|---------------------|--|
| <b>Response to Rule 312 Communication</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|   | 09/834,778             | SILVER ET AL.       |  |
|   | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|   | Daniel M Sullivan      | 1636                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

1. ☒ The amendment filed on 14 November 2003 under 37 CFR 1.312 has been considered, and has been:

a) ☐ entered.

b) ☐ entered as directed to matters of form not affecting the scope of the invention.


c) ☐ disapproved because the amendment was filed after the payment of the issue fee.

Any amendment filed after the date the issue fee is paid must be accompanied by a petition under 37 CFR 1.313(c)(1) and the required fee to withdraw the application from issue.

d) ☒ disapproved. See explanation below.

e) ☐ entered in part. See explanation below.

*The amendment to the specification incorporates new matter. Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. In re de Seversky, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). See MPEP § 608.01(p). An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim after the filing date of the application, the amendment is not proper. When a benefit claim is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. See Dart Indus. v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980).*

  
DAVID GUZO  
PRIMARY EXAMINER